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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/008,241	01/16/1998	DAVID S. STUTZ	777.115USR	6009

26119 7590 10/02/2003
KLARQUIST SPARKMAN LLP
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PORTLAND, OR 97204

EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
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2126

23

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/008,241

Applicant(s)

STUTZ ET AL.

Examiner

St. John Courtenay III

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

ST. JOHN COURTENAY III
PRIMARY EXAMINER

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Detailed Action

I. Prosecution Is Reopened

In view of the appeal brief filed on July 15, 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under **37 CFR 1.111** (if this Office action is non-final) or a reply under **37 CFR 1.113** (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (**37 CFR 1.130**, 1.131 or 1.132) or other evidence are permitted. See **37 CFR 1.193(b)(2)**.

II. Recapture/Broadening:

35 U.S.C. §251

Claims **48-49, 50, and 52** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See Hester Industries, Inc. v. Stein. Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. §251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

1. Claim 50: In the 04-24-95 amendment of the parent application, Applicant amended claim 33 of the parent application (renumbered as claim 27 of the patent), adding the following limitations:

- "each notification interface having an associated interface identifier,"
- "each instance of the connection point interface having an associated interface identifier,"
- "the selected instance having an associated interface identifier that corresponds to the interface identifier associated with the selected notification interface,"
- "the request has a reference to an instance...", and
- "storing the reference to the instance..."

New claim 50 omits those limitations.

2. New claim 52 omits similar limitations.

3. New claim 48 omits similar (and more) limitations.

4. Claim 49: Applicant amended claim 1 of the parent application, adding the following limitations:

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"selecting an instance... from among the instances... wherein the selection of the instance is based upon the interface identifier indicated in the received request."

New claim 49 omits these limitations.

These omissions broaden the scope of claims 48-49, 50, and 52, recapturing the subject matters that have been surrendered during the prosecution of the original application.

III. Defective reissue oath/declaration

The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR §1.175(a)(1) and MPEP § 1414. The statement of error is directed to improper recapturing of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See explanation, above.

Claims 1-53 are rejected as being based upon a defective reissue declaration under 35 U.S.C. §251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is **(703) 308-5217**. A voice mail service is also available at this number. Normal Flex work schedule: M – F 7:30 AM - 4:00 PM

- **All responses sent by U.S. Mail should be mailed to:
PLEASE NOTE NEW USPTO MAILING ADDRESS EFFECTIVE MAY 1, 2003**

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PTO FAX NUMBERS:


- **AFTER-FINAL OFFICIAL faxes must be signed and sent to:
(703) 746-7238.**
- **BEFORE-FINAL OFFICIAL faxes must be signed and sent to:
(703) 746-7239.**

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist:
(703) 305-3900.**

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:

Technical Center 2100 CUSTOMER SERVICE: 703 306-5631

The Manual of Patent Examining Procedure (MPEP) is available online at:
<http://www.uspto.gov/web/offices/pac/mpep/index.html>


ST. JOHN COURTENAY III
PRIMARY EXAMINER

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